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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/830,888   | 12/05/2001  | Ronald Huner         | 584.12-US1          | 5270             |
| 34284  | 7590        | 06/06/2006           | EXAMINER            |                  |
| ROBERT D. FISH<br>RUTAN & TUCKER LLP<br>611 ANTON BLVD 14TH FLOOR<br>COSTA MESA, CA 92626-1931 |             |                      | HOFFMANN, JOHN M    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1731                |                  |

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/830,888

Applicant(s)

HUNER, RONALD

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006 and 13 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-51, 53 and 54 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21, 26-51, 53 and 54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19, and 22-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I, claims 17-31 in the reply filed on 13 April 2006 is acknowledged. The traversal is on the ground(s) that there is no support in 37 CFR 1.471 or 37 CFR 1.499 for using a contested obviousness rejection to hold a lack of unity. This is not found persuasive because 37 CFR 1.499 makes no provision for avoiding a unity of invention requirement merely by contesting a rejection. Furthermore such does not appear to be reasonable because that would make mere gainsaying to be a sufficient basis for holding unity of invention as being improper. Since applicant has not pointed out any single general inventive concept – nor has applicant even suggested that there may be a single general inventive concept, it is deemed that applicant is not aware of one, and thus would agree that there is no single general inventive concept.

The requirement is still deemed proper and is therefore made FINAL.

Claims 32-51, 53, and 54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 13 April 2006.

Claims 20-21, 26-28 and 29-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no

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allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/02/2005. Applicant failed to indicate that these claims when amended would read on the elected species. Applicant had elected the coating agent of "diphenylcresylphosphate ester"; none of claims 20-21, 26-28 and 29-31 is directed to this ester. The agents of claims 20-21, 26-28 and 29-31 are mutually exclusive of the elected ester.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 22 be found allowable, claim 25 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17-19 , 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chopra 5768678 in view of any of Ezis 5358685, Hara 3859056, Mueller 3690930, Halberstadt 2666714, Segura 3573959 and Bordenca 3,401051, and further in view of Bradshaw 3669765 and Copelin 2789070.

See how the art was previously applied in the prior Office action. Furthermore, as indicated in applicant's response of Jan 17, 2006, page 9, last 5 lines: applicant acquiesces that the applicant did not discover the problem for which Applicant's is claiming a solution for. It is deemed not an invention to apply a known generic solution (i.e. coating unstable particles) to a specific particle.

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As to the new preamble language that the powder is a sintering additive: A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). A powder can be added to nearly anything – it can be added to any sintering process that one desires.

### ***Response to Arguments***

Applicant's arguments filed 17 Jan 2006 have been fully considered but they are not persuasive.

It is argued that Chopra offers a different solution from that of applicant's solution – and that solution is ignored in the rejection. The relevance of this argument is not understood. Chopra is merely cited as evidence that the present problem is well known. It appears that applicant's position is that a particular combination (i.e. combining the Chopra method with the secondary references) would not have been obvious. Examiner does not disagree – however such is not very relevant. Rather the particular issue is whether the combination of references as set forth in the rejection would have been obvious.

To look at it another way: Most references have many teachings. Thus there are many permutations and combinations of those teachings. The fact that applicant can find one particular combination that was not obvious is irrelevant as to whether some other combination would have been obvious. Since applicant has not addressed the specific combination as set forth in the rejection, it is deemed that applicant agrees with all the statements and conclusions set forth in the rejection. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant also points out that the primary and secondary references do not teach various limitations. This is largely unimportant because the tertiary references (Bradshaw and Copelin) provide the requisite teachings. The arguments regarding Copelin and Bradshaw are directed to claims that are not directed to the elected invention, and thus the arguments are moot.

It is also argued that there is no reasonable expectation of success. This is not well taken. Coating particles is hardly a difficult task. Applicant has provided any suggestion as to why one would think one could not coat well known particles with well-known powder coating compositions.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

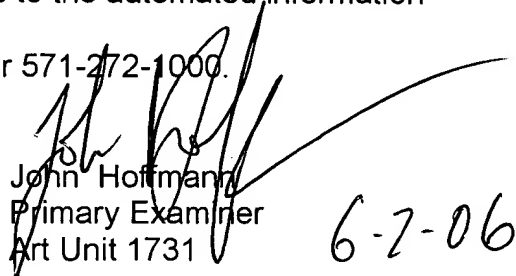
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John Hoffmann  
Primary Examiner  
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6-2-06

jmh